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Gordon R. Lindeen III
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
Seventh Floor
12400 Wilshire Boulevard
Los Angeles, CA 90025-1026

EXAMINER

LAMBRECHT, CHRISTOPHER M

ART UNIT

PAPER NUMBER

2623

DATE MAILED: 09/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/852,813

Applicant(s)

KITSUKAWA ET AL.

Examiner

Christopher M. Lambrecht

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 1/20/2006.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed January 3, 2006 have been fully considered but they are not persuasive.

On page 2 of the reply, Applicant argues:

Wistendahl merely discloses providing a halo around the options on the display available to the viewer. The halo around an option is not equivalent to an alert, as claimed, because the halo does not alert the viewer that advertising information is available for an item. Further, selecting the halo around an option does not lead to the display of the advertising information along with the broadcast of a program.

The examiner maintains that Wistendahl discloses the alert, as claimed.

Specifically, claims 1, 12, 19, and 26 require “displaying an advertising mark . . . to alert a viewer when advertising information is available[.]” Similarly, claims 32, 40, 46, and 51 require “providing an alert to the viewer when the advertising information is available[.]” Wistendahl “uses the object mapping data to highlight the display of interactive objects appearing in the TV content[.]” col. 3, ll. 59-61, such that the interactive objects “be identified visually for the viewer by a halo[.]” col. 14, ll. 36-38. In one embodiment, the interactive objects or “hot spots” are mapped to products in a home shopping show, “to allow switching to or overlaying (in a window) additional information or follow-on options about the product selected by the viewer.” Col. 13, ll. 50-54. Thus, the halo displayed around an interactive object on the display makes the viewer aware that additional information, such as advertising information, is available; and selecting the interactive object presents the advertising information on the display in

conjunction with the broadcast program. Therefore, Wistendahl discloses the limitations of “displaying an advertising mark . . . to alert a viewer when advertising information is available” and “providing an alert to the viewer when advertising information is available[.]”

Accordingly, the rejections of claims 1-55 are maintained as set forth in the prior Office action.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 1-4, 6-10, 12, 13, 15-17, 19-22, and 24-55** are rejected under 35

U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,496,981 to Wistendahl et al. (hereinafter “Wistendahl”).

Regarding **claims 1, 12, 19, and 26**, Wistendahl discloses a receiver, apparatus, and corresponding machine-readable medium of instructions for performing a method, comprising:

a storage device having stored therein an advertising routine (IDM program, col. 5, ll. 39-50) for the reception, timing, and display of advertising marks and associated program broadcasts and

a processor coupled to the storage device for executing the advertising routine (col. 8, ll. 36-48) by:

receiving advertising information for an item along with a broadcast of a program, wherein the item is associated with a scene of the program (col. 13, ll. 50-62);

receiving data that links the advertising information to the corresponding scene (col. 6, ll. 16-32 & 45-55);

displaying an advertising mark for the item on a display along with the corresponding scene to alert a viewer when advertising information is available for the item (col. 15, ll. 1-7); and

upon selection of the advertising mark by a viewer, displaying the advertising information on the display along with the broadcast of a program (col. 9, ll. 33-41).

As to **claims 2, 20, and 27**, Wistendahl discloses the receiver, apparatus, and corresponding machine-readable medium for performing the method of claims 1, 12, 19, and 26, wherein the advertising information is received simultaneously with the scene in which the item appears (col. 3, ll. 45-60).

As to **claims 3, 21, and 28**, Wistendahl discloses the receiver, apparatus, and corresponding machine-readable medium for performing the method of claim 1, 12, 19, and 26, wherein the advertising information is received prior to receipt of the broadcasted

program, and wherein the prior received advertising information is stored in association with the links to the corresponding scene (col. 7, l. 53 - col. 8, l. 8).

As to **claims 4, 13, 22, and 29**, Wistendahl discloses the receiver, apparatus, and corresponding machine-readable medium for performing the method of claims 1, 12, 19, and 26, further comprising controlling the presentation of the advertising information using an electronic program guide, where the electronic program guide provides programming information that can be associated with the links to the corresponding scene (col. 8, ll. 21-36).

As to **claims 6, and 15**, Wistendahl discloses the receiver, apparatus, and corresponding machine-readable medium for performing the method of claims 1, 12, 19, and 26, further comprising providing an alert to a viewer when advertising information is available for an item in a displayed scene, wherein the alert comprises a displayed advertising mark (col. 15, ll. 1-7).

As to **claim 7**, Wistendahl discloses the method of claim 1, wherein the displayed scene comprises currently displayed scenes, previously displayed scenes, and scenes that are to be displayed in the future (col.10, ll. 46-53).

As to **claims 8, 16, 24, and 30**, Wistendahl discloses the receiver, apparatus, and corresponding machine-readable medium for performing the method of claims 1, 12, 19, and 26, wherein the advertising information is for a plurality of items (col. 13, ll. 50-62), wherein the displayed advertising mark comprises an indicator for each item for which advertising information is available (col. 15, ll. 53-56), and wherein the indicator is

representative of the item to which the indicator corresponds (i.e., halos overlaying the interactive hot spots).

As to **claims 9, 17, 25, and 31**, Wistendahl discloses the receiver, apparatus, and corresponding machine-readable medium for performing the method of claims 8, 12, 19, and 26, further comprising receiving a viewer selection of an indicator corresponding to an item and displaying the advertising information associated with the corresponding item (col. 13, ll. 50-63).

As to **claim 10**, Wistendahl discloses the method of claim 1, further comprising receiving a request from the viewer for electronically ordering the item using the advertising information (col. 9, ll. 28-41).

Regarding **claim 32, 40, 46, and 51**, Wistendahl discloses a receiver, apparatus, and corresponding machine-readable medium of instructions for performing a method, comprising:

a storage device having stored therein an advertising routine (IDM program, col. 5, ll. 39-50) for reception, synchronization and display of advertising information and associated program broadcasts and

a processor (col. 8, ll. 36-48) coupled to the storage device for executing the advertising routine by:

receiving advertising information for at least one item along with a broadcast of a program (col. 13, ll. 50-62);

synchronizing the advertising information with the display of a corresponding at least one item during the broadcast of the program (col. 10, ll. 36-56)

providing an alert to the viewer when advertising information is available for the item (col. 15, ll. 1-7); and

displaying the advertising information on the display along with the broadcast of a program upon the receipt of a selection from the viewer (col. 9, ll. 33-41).

As to **claims 33, 41, 47, and 52**, Wistendahl discloses the receiver, apparatus, and corresponding machine-readable medium of instructions for performing the method of claims 32, 40, 46, and 51, further comprising providing an alert to a viewer when advertising information is available for an item in a displayed scene, wherein the alert comprises a displayed advertising mark (col. 15, ll. 1-7).

As to **claims 34, 42, and 48**, Wistendahl discloses the receiver, apparatus, and corresponding machine-readable medium of instructions for performing the method of claims 32, 40, and 46, wherein the at least one display mark is superimposed over the broadcast of a program on the display, and wherein the at least one display mark comprises an indicator for each advertisement (col. 15, ll. 53-56).

As to **claims 35, 43, and 49**, Wistendahl discloses the receiver, apparatus, and corresponding machine-readable medium of instructions for performing the method of claims 32, 40, and 46, further comprising enabling a request for the advertising information, wherein enabling a request comprises selecting an advertisement indicator corresponding to an item in which the viewer is interested (col. 9, ll. 33-41), and wherein

selecting the advertisement indicator results in the display of detailed advertisement information (col.13, ll. 50-62).

As to **claim 36**, Wistendahl discloses the method of claim 32, wherein displaying comprises superimposing the advertising information over the broadcast program on the display (col. 13, ll. 50-54).

As to **claims 37 and 53**, Wistendahl discloses the receiver and corresponding method of claims 32 and 51, wherein the advertising information is received simultaneously with the broadcast of a program (col. 3, ll. 45-60).

As to **claims 38, 44, and 54**, Wistendahl discloses the receiver and corresponding machine-readable medium of instructions for performing the method of claims 32, 40, and 51, wherein the advertising information is received prior to the broadcast of a program (col. 7, l. 53 - col. 8, l. 8).

As to **claims 39, 45, 50, and 55**, Wistendahl discloses the receiver, apparatus, and corresponding machine-readable medium of instructions for performing the method of claims 32, 40, 46, and 51, further comprising receiving timing data that links the advertising information to the corresponding broadcast of a program and wherein synchronizing the advertising information comprises using timing data (col. 10, ll. 46-56).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 5, 11, 18, and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wistendahl in view of U.S. Patent No. 5,285,278 to Holman (hereinafter "Holman").

Regarding **claims 5, 14, and 23**, Wistendahl discloses the receiver, apparatus, and corresponding machine-readable medium for performing the method claims 1, 12, 19, and 26, but fails to disclose storing received advertising information on a smart card; and storing information on the smart card regarding the associated broadcasted program in associated with the advertising information.

In an analogous art, Holman discloses storing received advertising information (coupon) on a smart card (microelectronic circuit card, col. 4, ll. 49-54 and col. 5, ll. 51-55); and storing information on the smart card regarding the associated broadcasted program in associated with the advertising information (col. 9, ll. 59-64), for the benefit of providing useful information to the product manufacturer (col. 9, ll. 59-64).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Wistendahl to include storing

received advertising information on a smart card; and storing information on the smart card regarding the associated broadcasted program in associated with the advertising information, as taught by Holman, for the benefit of providing useful information to the product manufacturer.

Regarding **claims 11 and 18**, Wistendahl discloses the receiver, apparatus, and corresponding machine readable medium for performing the method claims 1, 12, 19, and 26, further comprising storing advertising information for the item, but fails to disclose storing said information for a pre-specified period of time after the corresponding broadcasted program ends.

In an analogous art, Holman discloses storing advertising information (coupon) for an item for a pre-specified period of time after a corresponding broadcast program ends (col. 12, ll. 21-29), for the benefit of preventing abuse of a promotional offer (col. 12, ll. 21-37).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Wistendahl to include storing advertising information for an item for a pre-specified period of time after a corresponding broadcast program ends, as taught by Holman, for the benefit of preventing abuse of a promotional offer.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Lambrecht whose telephone number is (571) 272-7297. The examiner can normally be reached on Mon-Fri, 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher M. Lambrecht
Examiner
Art Unit 2623

cml



JOHN MILLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600